

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

REMARKS

Introductory Comments:

Claims 1-9 are pending in the application and were examined in the Office Action dated 18 December 2001. In that Action, the Office has asserted the following claim objections and rejections: (1) claims 7 and 9 were objected to under 37 C.F.R. §1.75(c) on matters of form; (2) claim 8 was objected to under 37 C.F.R. §1.75(c) on matters of form; (3) claims 1-5 stand rejected under 35 U.S.C. §101 as unpatentable over prior US Patent No. 6,328,714 to Bellhouse et al. ("Bellhouse1"); (4) claim 7 stands rejected under the judicially created doctrine of obviousness-type double patenting over Bellhouse1; and (5) claims 6 and 9 stand rejected under 35 U.S.C. §102(b) as unpatentable over U.S. Patent No. 5,630,796 to Bellhouse et al. ("Bellhouse2"). Applicants respectfully traverse these claim objections/rejections for the following reasons.

Overview of the Amendment:

Applicants, by way of this response, have cancelled claims 1-5 and 7-9 without prejudice and disclaimer. It is to be understood that cancellation of these claims is not meant to be an acquiescence to any rejection raised in the application, and applicants expressly reserve the right to bring the claims again in a subsequent, related application.

In addition, applicants have entered new claims 10-14. Claim 10 corresponds with cancelled claim 7, wherein the claim has merely been rewritten in independent form. Claim 12 corresponds with cancelled claim 8, wherein the claim has been rewritten to include the base limitations from

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

claims 1, 6 and 7. Claim 13 corresponds with cancelled claim 9, wherein the claim has merely been rewritten in independent form. Claims 11 and 14 are dependent upon claims 10 and 13, respectively, and merely recite different embodiments of the invention. Support for new claims 10-14 can be found in claims 1-5 and 7-9 as originally filed and throughout the specification at, for example, page 9, line 29 through page 16, line 26 and in Figures 1-9. Accordingly, no new matter has been added by way of these new claims, and the entry thereof is respectfully requested.

The Objections under 37 C.F.R. §175(c):

Claims 7-9 were objected to under 37 C.F.R. §1.75(c) as being of improper dependent or multiply dependent form. Applicants were required to either cancel the claims or to amend the claims to put them into proper form. As discussed herein above, applicants have cancelled claims 7-9, mooted the objections. In addition, applicants have provided herewith new claims 10-14 which recite the same devices as claim 7-9 and are presented in proper independent or dependent form. Accordingly, the objections to the claims under 37 C.F.R. §1.75(c) are deemed moot. Reconsideration and withdrawal of the objections is thus respectfully requested.

The Rejection under 35 U.S.C. §101:

Claims 1-5 stand rejected under 35 U.S.C. §101 on the basis of statutory double patenting over the earlier Bellhouse1 U.S. patent. In response, applicants draw the Office's attention to the claim amendments tendered herewith, wherein claims 1-5 have been cancelled. Accordingly, the

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

rejection under 35 U.S.C. §101 is deemed moot. Reconsideration and withdrawal is respectfully requested.

The Obviousness-Type Double Patenting Rejection:

Claim 7 stands rejected under the judicially created doctrine of obviousness-type double patenting over the earlier Bellhouse1 U.S. patent. Although claim 7 has been cancelled, mooting the present rejection, applicants will address the instant rejection with respect to new claims 10-14. In particular, the Office had objected that claim 7 was unpatentable over claim 1 of Bellhouse1 in the basis that claim 7 "fails to further limit the patented claim." Office Action at page 3. The Office further asserts that "although the conflicting claims are not identical, they are not patentably distinct ... because the intended use of the replaceable cartridge [of Bellhouse1 claim 1] is for a needleless syringe." Office Action at page 3. Applicants respectfully traverse.

Initially, with regard to claims 11-14, each of these new claims expressly recites a replaceable nozzle assembly. It is well established that the disclosure of Bellhouse1 cannot be used in the determination of whether or not claims 11-14 are obvious variations of claim 1 from Bellhouse1. Thus, the proper analysis for obviousness-type double patenting needs to look to claim 1 of Bellhouse1 to ascertain whether or not the replaceable nozzle assembly recited in claims 11-14 represents a mere obvious variation from the replaceable cartridge recited in Bellhouse1. Applicants respectfully submit that this cannot be the case. Claim 1 of Bellhouse1 relates in no way to a nozzle assembly, much less a nozzle assembly having the recited features of claims 11-14. Accordingly, claims 11-14 are deemed to be allowable over

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

Bellhouse1. Applicants respectfully solicit acknowledgment of this by way of an early allowance of claims 11-14.

With regard to claim 10, applicants note that claim 10 recites a reusable needleless syringe device containing, in operative combination, a nozzle, a source of compressed gas and a particle container. Claim 1 of Bellhouse1 recites a replaceable cartridge formed from a housing that contains a particle source and a source of compressed gas. Here again, the proper comparison under an obviousness-type double patenting assessment is the comparison between the language of claim 1 from Bellhouse1 and applicants' new claim 10. The disclosure provided by the Bellhouse1 specification cannot be used as prior art. Applicants submit that such a comparison must fail since there is no proper reading of claim 1 of Bellhouse1 that would result in the nozzle element recited in claim 10. There is likewise no proper reading of claim 1 of Bellhouse1 that would result in the feature that claim 10's recited device is a "reusable" needleless syringe. Both of these recited features may only be found by reading the Bellhouse1 specification and applying the same as prior art. This of course is not allowed. Accordingly, claim 10 is deemed allowable of Bellhouse1. Applicants respectfully solicit acknowledgment of this by way of an early allowance of claim 10.

The Rejection under 35 U.S.C. §102(b):

Claims 6 and 9 stand rejected under 35 U.S.C. §102(b) as unpatentable over Bellhouse2. More particularly, the Office asserts that Bellhouse2 "shows a particle acceleration nozzle 26 with a convergent upstream end 35 and a divergent downstream end 37 including a throat 36 connecting the convergent and divergent sections ... the upper portion of the nozzle is wider than the rest

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

of the nozzle, forming a projecting annular flange which provides an external shoulder," and "the cylindrical filter medium 39 surrounds the nozzle and rests upon the external shoulder." Office Action at pages 3-4, bridging paragraph. Applicants respectfully traverse.

Initially, applicants note that claim 9 has been cancelled by the amendment tendered herewith, rendering moot the rejection of that claim. With regard to claim 6, applicants note the following. Anticipation of a claim under § 102 *requires* that each and every element of the claims be inherent in, or disclosed expressly by the anticipating reference. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1057, 1064 (Fed. Cir. 1988). Exclusion of a single claimed element from a prior art reference is enough to negate anticipation by that reference. *Atlas Powder Co. v E.I. du Pont De Nemours & Co.* 224 USPQ 409, 411 (Fed. Cir. 1984). Further, anticipation basically requires identity with the prior art document (*Tyler Refrigeration v. Kysor Indus. Corp.*, 227 USPQ 845 (Fed. Cir. 1985)), where the identical invention must be shown in as complete detail as is contained in the rejected claim (*Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913 (Fed. Cir. 1989)). Finally, in order to anticipate, a prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States ITC*, 1 USPQ2d 1241 (Fed. Cir. 1986).

Bellhouse2 clearly fails to anticipate applicants' recited invention since it does not provide any disclosure whatsoever regarding applicants' recited combination of components, specifically, a nozzle assembly containing a nozzle with an outwardly projecting flange depending from its upstream end to provide an external shoulder and a filter medium that rests upon the external shoulder provided by the flange. The Office has tried to

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

equate applicants' recited flange/external shoulder feature with elements taken from the nozzle depicted in Figures 2 and 3 of Bellhouse2, in particular with the "upper portion" of the nozzle which is stated to be "wider than the rest of the nozzle." It is the Office's position that the silencer element 39 of Bellhouse2 "rests upon" this flange/shoulder element. Applicants respectfully submit that this is an improper reading of Bellhouse2.

In particular, applicants draw the Office's attention to the Bellhouse2 disclosure at column 12, lines 44-64 where the nozzle and silencer elements of Figures 2 and 3 are described. As stated by Bellhouse2, the silencer element 39 is "received on a cylindrical surface 40 of the nozzle and retained in position by the inter-engagement of an annular rib and groove 41." A quick review of the figures of Bellhouse2, specifically Figure 3, clearly shows that the grooves 41 are no where near the upper "wider" portion of the nozzle. Accordingly, contrary to the Office's assertions, Bellhouse2 does not show a nozzle with a flange on the upstream portion which provides a shoulder that a filter medium can rest upon. The silencer element of Bellhouse2 is held in place by a series of ribs on the nozzle that are found on the central part of the nozzle and extend to the downstream end of the nozzle, exactly opposite to applicants' recited configuration. Since Bellhouse2 does not disclose applicants' particular combination, it does not disclose each and every element of the claims as required under Section 102, and thus fails to anticipate applicants' invention.

For all of the foregoing reasons, then, the rejection of claim 6 under 35 U.S.C. §102(b) is improper. Reconsideration and withdrawal of the rejection is thus respectfully requested.

Atty Dkt No. OPF 22.02
USSN: 09/492,969
PATENT

CONCLUSION

Applicants respectfully submit that the claims as now pending define an invention that is novel and nonobvious over the art. Accordingly, allowance is believed to be in order and an early notification to that effect is earnestly solicited. Applicants further ask that, should the Examiner note any minor remaining issues that may be resolved with a telephone call, that he contact the undersigned in the UK at +44 1865 332 600.

Respectfully submitted,

Date: 18 June 2002

By:



Thomas P. McCracken
Registration No. 38,548

POWDERJECT PHARMACEUTICALS PLC
Florey House
The Oxford Science Park
Oxford OX4 4GA
United Kingdom
Telephone: +44 1865 332 600
Fax: +44 1865 332 601